

REMARKS

The present amendments and remarks are nearly identical to those of Applicants' response mailed February 6, 2006, the exception being that the present remarks address the rejection of claims 1, 9 and 20-21 under 35 U.S.C. § 103(a) as being unpatentable over Kuefner-Muehl et al., DE 197 35 800. Applicants' apologize for the previous omission and appreciate the opportunity to correct the mistake.

Claims 1 and 3-21 are pending in this application, claim 2 having been currently cancelled. Claims 1, 3 and 8-19 have been amended.

Claims 1 and 3-21 are presented for reconsideration.

The examiner asserts the specification has no Brief Description of the Drawing. The "drawing" is actually a figure. Applicants respectfully note the Brief Description of the Figures at the bottom of page 23.

Initially, applicants note that they have amended their claims in order to more particularly point out and distinctly claim a preferred aspect of their invention by delimiting claim to the scope of claim 2. Since claim 2 fails to further limit amended claim 1, it has been cancelled.

Additionally, applicants have cancelled "according to claim 1" in claims 8 and 9. No new matter has been added.

Claims 3 and 11-19 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Responsive thereto "either" has been deleted from claim 3, and claims 11-19 have been rewritten as proper method of use claims. Further, method claim 10 has been rewritten in independent form, with formula (1) defined as in originally filed claim 1.

It is respectfully submitted that all the claims submitted for reconsideration are in good formal order. Reconsideration and withdrawal of the rejection of claims 3 and 11-19 under 35 U.S.C. §112, second paragraph is therefore solicited.

Claims 8 and 9 are rejected under 35 U.S.C. § 112, first paragraph. The examiner states near the bottom of page 4 that the definition of R' as C₁-C₄alkyl is clearly an error. The examiner also asserts that reduction of the -(C=O)R' group will give a -CH₂R' group. Hence claim 8 does not disclose how to make the compounds with R₃ as claimed.

Applicants do not dispute that the examiner has pointed out a self-evident error in claim 8, one that any organic chemist should recognize and know how to correct. Re the level of skill in the art and predictability, applicants note that claim 8 uses all art-recognized steps, so the precursor R' moieties in the acylating agent are completely predictable, as is the product of the overall reaction sequence. Depending on whether the optional reduction of the -(C=O)R' group is carried out to give a -CH₂R'₃ group, the definitions of R'₃ as the residue of R₃ minus a CH₂ moiety, and R'₃ as the residue of R₃ minus a carbonyl moiety are thus self-evident. Additionally the corrected reaction scheme is supported by the preparation of compounds (104) – (126) listed in Table 1. Hence the present amendment to claim 8 adds no new matter to said claim.

With regard to claim 9, the examiner mentions a reduction step. Applicants respectfully note there is no reduction step in claim 9. Moreover, said claim is supported by Example 3 and the preparation of compounds (127) – (139) listed in Table 2.

It is respectfully submitted that compounds having the claimed scope of R₃ can be prepared by at least one of the processes claimed in claims 8 and 9. Reconsideration and withdrawal of the rejection of claims 8 and 9 under 35 U.S.C. §112, first paragraph is therefore solicited.

Claims 10-19 are rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully note the teachings on page 5, paragraph 2 and page 10, last 3 paragraphs of the disclosure. The perfect antimicrobial does not exist. There is no requirement that the claimed compounds be effective against all bacteria and all biofilms, just at least some. Certainly Examples 5-7 prove that.

In *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995), the court points out that it is error not to consider evidence presented in the specification. Also see *In re Armbruster*, 185 USPQ 152 (CCPA, 1975), especially page 153, where it is made clear that a specification does not have to convince one skilled in the art that the assertions therein are correct.

In *In re Goffe*, 191 USPQ 429, 431 (CCPA, 1976), the court stated:

to provide effective incentives claims must adequately protect inventors. *** To demand that that first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines for "preferred" materials in a process as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

Also see *In re Borkowski et al.*, 164 USPQ 642 (CCPA, 1970).

Generally in patent practice, the preparative examples, use examples and the tables of compounds in the specification are considered as an illustration of the claimed invention, but they are not deemed to limit the invention to what has been demonstrated.

Reconsideration and withdrawal of the rejection of claims 10-19 under 35 U.S.C. § 112, first paragraph is respectfully solicited in light of the remarks *supra*.

Claims 11-19 are rejected under 35 U.S.C. § 101. Applicants aver that the amendments to said claims above have overcome this rejection. Reconsideration and withdrawal of said rejection is therefore respectfully solicited.

Claims 1, 9 and 20-21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kuefner-Muehl et al., DE 197 35 800. Applicants note this application was published February 25, 1999, so its teachings are also available with regard to the "how to make" enablement issue.

The examiner asserts that pages 13-14 teach the process of claim 9 and points to Table 5, examples 104-108 as disclosing certain claimed compounds where, in their formula (I), $R_1 = R_2 = H$; $R_3 = 3$ -pyridyl and $R_4 = \text{alkyl or cycloalkyl}$. However, compounds where, in their formula (I), $R_1 = R_2 = H$ are not claimed. Hence there is no anticipation by this reference.

Claim 1 is rejected under 35 U.S.C. § 102(b) as being anticipated by the abstract of the Kelarev et al. article. However, in all instances, the triazine ring is substituted by $-NH_2$. Such compounds are not claimed. Hence there is no anticipation by this reference.

Claims 1, 9 and 20-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kuefner-Muehl et al., DE 197 35 800. The examiner asserts that it would be obvious to make any of the variously substituted pyridyltriazines allowed by DE 197 35 800 and expect the same activity taught therein.

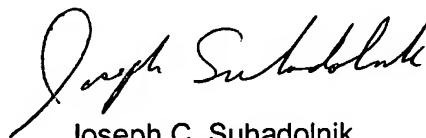
Applicants note that Table 5, beginning on page 23 of Kuefner, lists 193 compounds, 85 of which (examples 103-188) are substituted with 3-pyridyl. However, none of the 85 pyridyl substituted examples bear any amino substituents at R1 and R2 other than hydrogen. Of the 193 compounds, only examples 3 and 4, neither of which bears a pyridyl substituent, is substituted on the nitrogen with a R1=H and R2 =alkyl. Applicants therefore respectfully maintain that, given the variability associated with the biological activity of organic compounds, it could not rightfully be expected that triazines bearing a pyridyl substituent and a mono-alkyl amino substituent would have the same activity of the other exemplified compounds. Applicants kindly ask that the 103(a) rejections be withdrawn.

Claims 4-7 are objected to as being dependent upon a rejected base claim. Applicants aver that, in light of the amendment to claim 1, said rejection has been overcome. Reconsideration and withdrawal of said rejection is therefore respectfully solicited.

Since there are no other grounds of objection or rejection, passage of this application to issue with claims 1 and 3-21 is earnestly solicited.

Applicants submit that the present application is in condition for allowance. In the event that minor amendments will further prosecution, Applicants request that the examiner contact the undersigned representative.

Respectfully submitted,



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